



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,937	03/25/2004	Geoffrey H. Gorres	16360-002001	6884
26191	7590	10/10/2006		
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BEFUMO, JENNA LEIGH	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 10/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/808,937		GORRES, GEOFFREY H.	
	Examiner		Art Unit	
	Jenna-Leigh Befumo		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 19, 2006 has been entered.

Response to Amendment

2. The Amendment submitted on September 19, 2006, has been entered. Claim 9 has been cancelled. Claims 1 and 12 have been amended. Claims 1 – 24 are pending. Claims 14 – 24 are withdrawn from consideration as being drawn to a nonelected invention.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 – 6, 10, and 13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Huber et al. (5,066,529) for the reasons of record.

5. Claims 1 – 6, 10, and 13 stand rejected under 35 U.S.C. 102(e) as being anticipated by Mullis (2002/0083507) for the reasons of record.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1771

7. Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Huber et al. or Mullis in view of Lee (4,792,471) or Crawford (4,517,230) for the reasons of record.

8. Claims 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Huber et al. in view of Bylund et al. (5,486,385) for the reasons of record.

9. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Huber et al. in view of Hamilton (5,010,589) for the reasons of record.

Response to Arguments

10. Applicant's arguments filed September 19, 2006 have been fully considered but they are not persuasive. The applicant argues that Huber et al. doesn't teach a self-adherent substrate that sticks to itself and not to the object to which it is applied (response, page 5). However, for the reasons set forth in the previous Office Action, Huber teaches using a self-adherent wrap. Huber specifically teaches that the wrap is made by the methods disclosed in Hansen (3,575,782) which teaches self-adherent webs or tapes. The applicant's own specification admits that Hansen teaches how to produce self-adherent wraps (page 4, lines 3 – 5). Further, Huber et al. discloses various materials can be used to form the tape substrate and that the tape may be bare backed (i.e., no adhesive) or coated with a pressure-sensitive adhesive (column 3, lines 2 – 4). Hence, Huber et al. does not require an adhesive layer. Therefore, both Huber and the applicant teach applying a camouflage print to the same web material, which would inherently have the same properties.

11. The applicant also argues that Huber et al. teaches away from the prior art because the camouflage pattern is applied at an angle (response, page 5 – 6). However, the present claim does not exclude that the camouflage pattern is applied in any angled or stretched pattern. There

Art Unit: 1771

is nothing in the claim that limits how the camouflage pattern is applied. Further, varying the camouflage design applied to fabric is a design variation in the printed pattern applied to the surface and does not structurally effect the claimed product. In other words, the structural features claimed are a self-adherent wrap with a camouflage patterned applied to the surface. Thus, the prior art teaches the claimed structural limitations, and the rejection is maintained.

12. The applicant argues that the invention disclosed by Mullis does not teach a self-adherent material as recited in claim 1 because Mullis discloses a band and not a wrap (response, page 6). However, the band meets the claimed definition of self-adherent since it does not adhere to the material it is covering and does not require fasteners. The applicant argues the ordinary meaning of a band does not read on a wrap. The applicant defines a band as a thin, flat, encircling strip and a wrap as a material that is wound or coiled so as to encircle or cover something. First, the term “wrap” in the claim is a preamble limitation which is not given any weight. Second, both a wrap and a band are a material that is used to encircle something. Hence, a band is a type of wrap. Thus, the rejection is maintained.

13. The applicant argues that the 35 USC 103 rejections based on Huber et al. or Mullis should be withdrawn since these references fail to teach the claimed wrap (response, pages 6 – 7). However, as set forth above, both these references do teach using a claimed material. Thus, the rejections are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

Art Unit: 1771

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jlb
September 27, 2006


JENNA BEFUMO
PRIMARY EXAMINER